

**FACEBOOK’S OBJECTIONS TO LEADER’S PROPOSED JURY
INSTRUCTION NO. 4.7**

Facebook objects to Leader’s provision of a date of filing that is in dispute. Any reference to the date of filing should not include an actual date, as whether Leader is entitled to the benefit of its provisional application is in dispute.

Facebook believes the jury should be informed of the Federal Circuit’s holding in *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 269 F.3d 1321, 1328 (Fed. Cir. 2001), that “An offer for sale need not be accepted to trigger the on-sale bar. That the offer, even if accepted, might not have ultimately led to an actual sale of the invention is also not relevant.” Otherwise, Facebook relies on primarily on Final Jury Instruction No. IV.7, used in this Court’s case, *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 04-cv-1371-JJF (D. Del. Sept. 21, 2007). The jury should also be informed that it is irrelevant whether or not the offer for sale was secret or non-secret. *See Mfg. Research Corp. v. Graybar Elec. Co.*, 679 F.2d 1355, 1362 (11th Cir. 1982) (“[I]t is well established that any sale or offer, whether public or private, is enough to implicate the statutory bar.”).

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.7
ON SALE BAR

Facebook contends that claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are invalid because the alleged invention of these claims was offered for sale more than one year before the effective filing date of the '761 patent. It is against public policy to allow an inventor to commercially exploit his invention by selling or offering it for sale more than one year before the effective filing date of the patent, because this would have the effect of extending the term of the patent as fixed by Congress. The date one year prior to the filing of the patent application is called the "critical date."

A patent claim is invalid if an embodiment of the claimed invention was both (1) subject to commercial offer for sale in the United States; and (2) ready for patenting more than one year before the patent application date.

An invention was "on sale" if the claimed invention was embodied in the thing commercially offered for sale. An offer for sale need not be accepted to trigger the on-sale bar. That the offer, even if accepted, might not have ultimately led to an actual sale of the invention is also not relevant. It is not required that a sale has actually been made. The essential question is whether or not there was an attempt to obtain commercial benefit from the invention. An offer to sell can invalidate a patent even if the offer was secret, such as under the protection of a non-disclosure agreement, or publicly known.

An invention is ready for patenting either through a reduction to practice (for example, by building a product that embodies the claimed invention) or by proof that the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.

AUTHORITY:

Modified Final Jury Instruction No. IV.7, *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 04-cv-1371-JJF (D. Del. Sept. 21, 2007); *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 269 F.3d 1321, 1328-29 (Fed. Cir. 2001).

Modified AIPLA Model Jury Instructions § 6.3 (March 2008) which cites 35 U.S.C. § 102; *Pfaff v. Wells Elecs.*, 525 U.S. 55, 67-68 (1998); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1352-55 (Fed. Cir. 2002); *Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1047-54 (Fed. Cir. 2001); *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1045-49 (Fed. Cir. 2001).

Mfg. Research Corp. v. Graybar Elec. Co., 679 F.2d 1355, 1362 (11th Cir. 1982).

LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY

INSTRUCTION NO. 4.7

Leader objects to this proposed instruction as it is unnecessary and for all the reasons set forth in Leader's motion *in limine* No. 5. Furthermore, the proposed instruction will confuse the jury to have a discussion regarding the public policy issue. Leader further objects to the addition of language from the *Scaltech v. Retec* case as confusing. To the extent this additional language is conveying the same law already provided in the instruction, it is unnecessary and redundant.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.8

EXPERIMENTAL USE

Leader contends that demonstrations should not be considered a prior public use of the invention because that use was experimental. The law recognizes that the inventor must be given the opportunity to develop the invention through experimentation. Certain activities are experimental if they are a legitimate effort to perfect the invention or to determine if the invention will work for its intended purpose. So long as the primary purpose is experimentation, it does not matter that the public used the invention or that the inventor incidentally derived profit from it. If you find that Facebook has shown a prior public use by clear and convincing evidence, then Leader must prove by a preponderance of the evidence that the purpose of the prior public use was experimental.

Only experimentation by or under the control of the inventor of the patent qualifies for this exception. Experimentation by a third party, for its own purposes, does not. The experimentation must relate to the features of the claimed invention, and it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is not an experimental use, but a public use.

AUTHORITY:

Modified AIPLA Model Jury Instructions § 6.4 (March 2008) which cites *City of Elizabeth v. Am. Nicholson Pavement Co.*, 97 U.S. 126, 134-35 (1877); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1353-55 (Fed. Cir. 2002); *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 1071-72 (Fed. Cir. 1992); *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 549-51 (Fed. Cir. 1990); *U.S. Env'tl. Prods. Inc. v. Westall*, 911 F.2d 713, 716 (Fed. Cir. 1990); *In re Hamilton*, 882 F.2d 1576, 1580-83 (Fed. Cir. 1989); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988); *Hycor Corp. v. Schlueter Co.*, 740 F.2d 1529, 1535-37 (Fed. Cir. 1984);

Pennwalt Corp. v. Akzona Inc., 740 F.2d 1573, 1580-81 (Fed. Cir. 1984); *TP Labs., Inc. v. Profl Positioners, Inc.*, 724 F.2d 965, 972-73 (Fed. Cir.), *cert. denied*, 469 U.S. 826 (1984); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1149-50 (Fed. Cir. 1983); *In re Smith*, 714 F.2d 1127, 1134-37 (Fed. Cir. 1983); *In re Theis*, 610 F.2d 786, 792-93 (C.C.P.A. 1979).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.8**

It is difficult to even begin to address the numerous flaws with this instruction. The first sentence, “[d]emonstrations should not be considered a prior public use of the invention because that use was experimental,” is an utter misstatement of the law because it assumes that all demonstrations are “experimental uses” regardless of their circumstances.

Leader does not cite to any authority that demonstrating products to potential investors or customers is “experimental use,” and demonstrations for the purpose of obtaining investment or customers are the type of public uses Facebook contends are invalidating. As Leader’s own instruction explains, “[a] test done primarily for marketing, and only incidentally for technological improvement, is not an experimental use, but a public use.” Thus, this instruction will merely confuse the issues for the jury.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.8
EXPERIMENTAL USE

Leader contends that its demonstrations of its Leader2Leader product should not be considered a prior public use of the invention because that use was experimental.

The law recognizes that the inventor must be given the opportunity to develop the invention through experimentation. Activities are only experimental if they are a legitimate effort to perfect the invention or to determine if the invention will work for its intended purpose. If you find that Facebook has shown a prior public use by clear and convincing evidence, then Leader must prove by a preponderance of the evidence that the purpose of the prior public use was experimental.

Only experimentation by or under the control of the inventor of the patent qualifies for this exception. Experimentation by a third party, for its own purposes, does not. The experimentation must relate to the features of the claimed invention, and it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is not an experimental use, but a public use.

AUTHORITY:

Modified APLA Model Jury Instructions § 6.4 (March 2008) which cites *City of Elizabeth v. Am. Nicholson Pavement Co.*, 97 U.S. 126, 134-35 (1877); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1353-55 (Fed. Cir. 2002); *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 1071-72 (Fed. Cir. 1992); *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 549-51 (Fed. Cir. 1990); *U.S. Envtl. Prods. Inc. v. Westall*, 911 F.2d 713, 716 (Fed. Cir. 1990); *In re Hamilton*, 882 F.2d 1576, 1580-83 (Fed. Cir. 1989); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988); *Hycor Corp. v. Schlueter Co.*, 740 F.2d 1529, 1535-37 (Fed. Cir. 1984); *Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1580-81 (Fed. Cir. 1984); *TP Labs., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 972-73 (Fed. Cir.), *cert. denied*, 469 U.S. 826 (1984); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1149-50 (Fed. Cir. 1983); *In re Smith*, 714 F.2d 1127, 1134-37 (Fed. Cir. 1983); *In re Theis*, 610 F.2d 786, 792-93 (C.C.P.A. 1979).

**LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY
INSTRUCTION NO. 4.8**

Leader objects to Facebook's inclusion of the word "only" in this jury instruction. *See, e.g.*, "Activities are only experimental . . ." Facebook attempts to add an improper limitation into experimental activities. The inclusion of the word "only" is argumentative and prejudicial to Leader.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.9

PRINTED PUBLICATION/PRIOR PATENT

Facebook contends that claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are anticipated because the invention defined in those asserted claims were allegedly described in a printed publication or patent more than one year before the filing date of the '761 Patent

A printed publication must be reasonably accessible to those members of the public who would be interested in its contents. It is not necessary that the printed publication be available to every member of the public. The information must, however, have been maintained in some form, such as printed pages, microfilm, or photocopies. An issued patent is a printed publication. A published patent application is a printed publication as of its publication date.

For a printed publication to anticipate a patent claim, it must, when read by a person of ordinary skill in the art, expressly or inherently disclose each element of the claimed invention to the reader. The disclosure must be complete enough to enable one of ordinary skill in the art to practice the invention without undue experimentation.

To prove anticipation of the patented invention, Facebook must show by clear and convincing evidence that before December 11, 2001 a third party disclosed in a printed publication or patented an invention that included all of the elements of the asserted claims of the '761 Patent.

AUTHORITY:

Modified AIPLA Model Jury Instructions §§ 6.5 and 6.7 (March 2008) which cites 35 U.S.C. § 102; *In re Carol F. Klopfenstein*, 380 F.3d 1345, 1352 (Fed. Cir. 2004); *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554-55 (Fed. Cir. 1995); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568-69 (Fed. Cir. 1988); *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986); *In re Hall*, 781 F.2d 897, 898-899 (Fed. Cir. 1986); *In re Donohue*, 766 F.2d 531, 533-34 (Fed. Cir. 1985); *Studiengesellschaft Kohle mbH v. Dart Indus., Inc.*, 726 F.2d 724, 727 (Fed. Cir. 1984); *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981); *In re Donohue*, 632 F.2d 123, 125-126 (C.C.P.A. 1980); *In re Samour*, 571 F.2d 559, 562 (C.C.P.A. 1978); *In re Coker*, 463 F.2d 1344, 1348 (C.C.P.A. 1972); *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 1235 (7th Cir. 1969); *In re Foster*, 343 F.2d 980, 984-985 (C.C.P.A. 1965); *In re Monks*, 588 F.2d 308, 309 (C.C.P.A. 1978); *In re Fuge*, 272 F.2d 954, 956 (C.C.P.A. 1959); *In re Ekenstam*, 256 F.2d 321, 323-24 (C.C.P.A. 1958); *Bendix Corp. v. Balax, Inc.*, 421 F.2d 809, 811-12 (7th Cir. 1970).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.9**

Facebook objects to the addition of a paragraph to the end of the AIPLA model jury instruction and to the inclusion of the date "December 11, 2001" as the date before which publications must have been printed, as this date is based off of Leader's provisional patent application, and the parties are in dispute as to whether that application properly disclosed the asserted claims of the '761 patent.

Further, in *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) the Federal Circuit found that a U.S. patent used as prior art is presumed enabled as to what it discloses.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.9
PRINTED PUBLICATION/PRIOR PATENT

Facebook contends that claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are anticipated because the invention defined in that claim was described in a printed publication or a patent more than one year before the date of filing of the '761 patent application.

A patent claim is invalid if the invention defined by that claim was described in a printed publication more than one year prior to the filing date of the U.S. application, December 10, 2003.

A printed publication must be reasonably accessible to those members of the public who would be interested in its contents. It is not necessary that the printed publication be available to every member of the public. The information must, however, have been maintained in some form, such as printed pages, microfilm, or photocopies. An issued patent is a printed publication. A published patent application is a printed publication as of its publication date.

For a printed publication to anticipate a patent claim, it must, when read by a person of ordinary skill in the art, expressly or inherently disclose each element of the claimed invention to the reader. The disclosure must be complete enough to enable one of ordinary skill in the art to practice the invention without undue experimentation. However, when the printed publication is an issued U.S. Patent, that patent is presumed to be enabling. In determining whether the disclosure of other printed publications is enabling, you should take into account what would have been within the knowledge of a person of ordinary skill in the art one year before the application for the '761 Patent was filed and you may consider evidence that sheds light on the knowledge such a person would have had, including whether or not the disclosures were embodied in working products.

AUTHORITY:

Modified AIPLA Model Jury Instructions §§ 6.5 and 6.7 (March 2008) which cites 35 U.S.C. § 102; *In re Carol F. Klopfenstein*, 380 F.3d 1345, 1352 (Fed. Cir. 2004); *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554-55 (Fed. Cir. 1995); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568-69 (Fed. Cir. 1988); *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986); *In re Hall*, 781 F.2d 897, 898-899 (Fed. Cir. 1986); *In re Donohue*, 766 F.2d 531, 533-34 (Fed. Cir. 1985); *Studiengesellschaft Kohle mbH v. Dart Indus., Inc.*, 726 F.2d 724, 727 (Fed. Cir. 1984); *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981); *In re Donohue*, 632 F.2d 123, 125-126 (C.C.P.A. 1980); *In re Samour*, 571 F.2d 559, 562 (C.C.P.A. 1978); *In re Coker*, 463 F.2d 1344, 1348 (C.C.P.A. 1972); *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 1235 (7th Cir. 1969); *In re Foster*, 343 F.2d 980, 984-985 (C.C.P.A. 1965); *In re Monks*, 588 F.2d 308, 309 (C.C.P.A. 1978); *In re Fuge*, 272 F.2d 954, 956 (C.C.P.A. 1959); *In re Ekenstam*, 256 F.2d 321, 323-24 (C.C.P.A. 1958); *Bendix Corp. v. Balax, Inc.*, 421 F.2d 809, 811-12 (7th Cir. 1970).

Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1355 (Fed. Cir. 2003).

**LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY
INSTRUCTION NO. 4.9**

_____Leader objects to Facebook's proposed jury instruction as it confuses the issues of anticipation and enablement and is argumentative. It is a misstatement of law to claim that a U.S. patent is "presumed to be enabling" of the claimed invention of another patent when it is being asserted as prior art to the later patent. There is no law to support any claim by Facebook that any issued patent that is being asserted as prior art to the '761 Patent is presumed enabled for anticipation purposes. Facebook's instruction is a misstatement of the law and prejudicial to Leader under FRE 403. Additionally, Leader objects to Facebook's insertion of the December 11, 2003 date, as the effective filing date of the patent is a dispute issue in this case.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.10
OBVIOUSNESS – GENERALLY

Even though an invention may not have been identically disclosed or described before it was made by an inventor, in order to be patentable, the invention must also not have been obvious to a person of ordinary skill in the field of technology of the patent at the time the invention was made.

Facebook may establish that a patent claim is invalid by showing, by clear and convincing evidence, that the claimed invention would have been obvious to persons having ordinary skill in the art at the time the invention was made in the field of computer science.

In determining whether a claimed invention is obvious, you must consider the level of ordinary skill in the field of computer science that someone would have had at the time the claimed invention was made, the scope and content of the prior art, and any differences between the prior art and the claimed invention.

Keep in mind that the existence of each and every element of the claimed invention in the prior art does not necessarily prove obviousness. Most, if not all, inventions rely on building blocks of prior art. In considering whether a claimed invention is obvious, you may but are not required to find obviousness if you find that at the time of the claimed invention there was a reason that would have prompted a person having ordinary skill in the field of computer science to combine the known elements in a way the claimed invention does, taking into account such factors as (1) whether the claimed invention was merely the predictable result of using prior art elements according to their known function(s); (2) whether the claimed invention provides an obvious solution to a known problem in the relevant field; (3) whether the prior art teaches or

suggests the desirability of combining elements claimed in the invention; (4) whether the prior art teaches away from combining elements in the claimed invention; (5) whether it would have been obvious to try the combinations of elements, such as when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions; and (6) whether the change resulted more from design incentives or other market forces. To find it rendered the invention obvious, you must find that the prior art provided a reasonable expectation of success.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c (February 2010) which cites *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 407, 425-28 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161-62 (Fed. Cir. 2007); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662-63 (Fed. Cir. 2000); *Arkies Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 955 (Fed. Cir. 1997); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991); *Nutrition 21 v. U.S.*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991); *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 764 (Fed. Cir. 1988); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 718-19 (Fed. Cir. 1984); *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382-83 (Fed. Cir. 1983); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-40 (Fed. Cir. 1983).

FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.10

Facebook objects to this instruction as it divides up several obviousness instructions into individual instructions.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.10
OBVIOUSNESS – GENERALLY

Even though an invention may not have been identically disclosed or described before it was made by an inventor, in order to be patentable, the invention must also not have been obvious to a person of ordinary skill in the field of technology of the patent at the time the patent was filed.

Facebook may establish that the patent claims are invalid by showing that the claimed invention would have been obvious to persons of ordinary skill in the art at the time the patent filed.

In determining whether a claimed invention is obvious, you must consider the level of ordinary skill in the field of computer science that someone would have had at the time the claimed invention was made, the scope and content of the prior art, and any differences between the prior art and the claimed invention.

[A person of ordinary skill in the art is someone with a bachelor's degree or higher in computer science and/or several years of experience in the computer industry.]

[A person of ordinary skill in the art is someone with a bachelor's degree or the equivalent in computer science and several years of experience in the computer industry.]

Keep in mind that the existence of each and every element of the claimed invention in the prior art does not necessarily prove obviousness. Most, if not all, inventions rely on building blocks of prior art. In considering whether a claimed invention is obvious, you may find obviousness if you find that at the time of the claimed invention there was a reason that would have prompted a person having ordinary skill in the field of computer science to combine the known elements in a way the claimed invention does, taking into account such factors as (1) whether the claimed invention was merely the predictable result of using prior art elements according to their known function(s); (2) whether the claimed invention provides an obvious solution to a known problem in the relevant field; (3) whether the prior art teaches or suggests the desirability

of combining elements claimed in the invention; (4) whether the prior art teaches away from combining elements in the claimed invention; (5) whether it would have been obvious to try the combinations of elements, such as when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions; and (6) whether the change resulted more from design incentives or other market forces. To find it rendered the invention obvious, you must find that the prior art provided a reasonable expectation of success.

In determining whether the claimed invention was obvious, consider each claim separately. Consider only what was known at the time of the invention; do not use hindsight.

In making these assessments, you should take into account any objective evidence (sometimes called “secondary considerations”) that may have existed at the time of the invention and afterwards that may shed light on the obviousness or not of the claimed invention, such as:

- a. Whether the invention was commercially successful as a result of the merits of the claimed invention (rather than the result of design needs or market-pressure advertising or similar activities)?
- b. Whether there was a long felt need for a solution to the problem facing the inventors, which was satisfied by the claimed invention?
- c. Whether others had tried and failed to make the invention?
- d. Whether others invented the invention at roughly the same time?
- e. Whether others copied the invention?
- f. Whether there were changes or related technologies or market needs contemporaneous with the invention?
- g. Whether the invention achieved unexpected results?
- h. Whether others in the field praised the invention?

- i. Whether persons having ordinary skill in the art of the invention expressed surprise or disbelief regarding the invention?
- j. Whether others sought or obtained rights to the patent from the patent holder?
- k. Whether the inventor proceeded contrary to accepted wisdom in the field?

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c (February 2010) which cites *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 407, 425-28 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161-62 (Fed. Cir. 2007); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662-63 (Fed. Cir. 2000); *Arkies Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 955 (Fed. Cir. 1997); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991); *Nutrition 21 v. U.S.*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991); *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 764 (Fed. Cir. 1988); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 718-19 (Fed. Cir. 1984); *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382-83 (Fed. Cir. 1983); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-40 (Fed. Cir. 1983).

**LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY
INSTRUCTION NO. 4.10**

Leader objects to Facebook's proposed instruction as lengthy and likely to confuse the jury. Leader has instead proposed breaking up the model Federal Circuit jury instruction into separate instructions to make it less confusing for the jury. Furthermore, Facebook's proposed instruction incorrectly asserts that the parties have stipulated to the level of ordinary skill. Leader further objects to this proposed instruction for the same reasons provided in its motion *in limine* No. 2.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.11
OBVIOUSNESS – HINDSIGHT

In determining whether the claimed invention was obvious, consider each claim separately. Do not use hindsight, i.e., consider only what was known at the time of the invention.

AUTHORITY:

The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c (February 2010) which cites *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

**FACEBOOK'S OBJECTION TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.11**

Facebook objects to this instruction, as this information should be included, if at all, in the Obviousness – Generally instruction, as it is in the Federal Circuit Bar Association Model Instruction § 4.3c. For Facebook's proposed instruction regarding hindsight, see Facebook's Proposed Jury Instruction No. 4.10, Obviousness – Generally. Leader is attempting to focus the jurors purely on "hindsight" separate from the rest of the obviousness requirements for confusion's sake.

DISPUTED PROPOSED JURY INSTRUCTION NO. 4.12
SCOPE AND CONTENT OF THE PRIOR ART

In considering whether the claimed invention was obvious, you must first determine the scope and content of the prior art.

The scope and content of prior art for deciding whether the invention was obvious includes prior art in the same field as the claimed invention, regardless of the problem addressed by the item or reference, and prior art from different fields that a person of ordinary skill in the art using common sense might combine if familiar so as to solve the problem, like fitting together the pieces of a puzzle. [When a party attacking the validity of a patent relies on prior art which was specifically considered by the Examiner during the prosecution of the application leading to the issuance of the patent, that party bears the burden of overcoming the deference due a qualified government agency official presumed to have performed his or her job.]

AUTHORITY:

The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c(ii) (February 2010) which cites *KSR*, 550 U.S. at 420; *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007); *Princeton Biochems., Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1339 (Fed. Cir. 2005).

**FACEBOOK’S OBJECTIONS TO DISPUTED PROPOSED JURY
INSTRUCTION NO. 4.12**

Facebook objects to the sentence “When a party attacking the validity of a patent relies on prior art which was specifically considered by the Examiner during the prosecution of the application leading to the issuance of the patent, that party bears the burden of overcoming the deference due a qualified government agency official presumed to have performed his or her job” because Facebook is not relying on any prior art that was before the patent office in presenting its obviousness case. This sentence is prejudicial, misleading, confusing, and irrelevant.

In addition, the PTO has already stated that none of the prior art upon which Facebook relies was reviewed by the Examiner during the prosecution of the ’761 patent in the orders granted the *ex parte* and *inter partes* reexaminations of the ’761 patent.

**LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY
INSTRUCTION NO. 4.12**

Leader objects to the deletion of the last sentence as incomplete. Furthermore,
Leader objects to this instruction as incomplete as the entire instruction should be
provided in light of Facebook's positions taken in this case.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.13

**DIFFERENCES BETWEEN THE INVENTION OF
THE CLAIMS AND THE PRIOR ART**

You should analyze whether there are any relevant differences between the prior art and the claimed invention from the view of a person of ordinary skill in the art at the time of the invention. Your analysis must determine the impact, if any, of any such differences on the obviousness or nonobviousness of the invention as a whole, and not merely some portion of it. In analyzing the relevance of the differences between the claimed invention and the prior art, you do not need to look for precise teaching in the prior art directed to the subject matter of the claimed invention. You may take into account the inferences and creative steps that a person of ordinary skill in the art would have employed in reviewing the prior art at the time of the invention. For example, if the claimed invention combined elements known in the prior art and the combination yielded results that were predictable to a person of ordinary skill in the art at the time of the invention, then this evidence would make it more likely that the claim was obvious. On the other hand, if the combination of known elements yielded unexpected or unpredictable results, or if the prior art teaches away from combining the known elements, then this evidence would make it more likely that the claim that successfully combined those elements was not obvious.

Importantly, a claim is not proved obvious merely by demonstrating that each of the elements was independently known in the prior art. Most, if not all, inventions rely on building blocks long since uncovered, and claimed discoveries almost of necessity will likely be combinations of what is already known. Therefore, you should consider whether a reason existed at the time of the invention that would have prompted a person of ordinary skill in the art in the relevant field to combine the known elements in the way the claimed invention does. The reason could come from the prior art, the background

knowledge of one of ordinary skill in the art, the nature of the problem to be solved, market demand, or common sense.

If you find that a reason existed at the time of the invention to combine the elements of the prior art to arrive at the claimed invention, the evidence would make it more likely that the claimed invention was obvious.

Again, you must undertake this analysis separately for each claim that Facebook contends is obvious.

AUTHORITY:

Modified AIPLA's Model Patent Jury Instructions § 7.2 (March 2008) which cites *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742-43 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1536-37 (Fed. Cir. 1983); *Medtronic, Inc., v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567-68 (Fed. Cir. 1983).

**FACEBOOK’S OBJECTIONS TO LEADER’S PROPOSED JURY
INSTRUCTION NO. 4.13**

Facebook does not believe this instruction is necessary, as it is duplicative of other instructions. For the “Obviousness – General,” “Obviousness – Hindsight,” and “Obviousness – Objective Considerations Concerning Non-obviousness” instructions, Leader relies on the Federal Circuit Bar Association’s “Obviousness” Instruction No. 4.3c. Leader then attempts to add in a redundant instruction from the AIPLA Model Instructions. This is unnecessary and is just an attempt to confuse the jury with “additional,” although redundant, requirements for finding obviousness.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.14

LEVEL OF ORDINARY SKILL

In deciding what the level of ordinary skill for the '761 Patent is, you should consider all the evidence introduced at trial, including but not limited to: (1) the levels of education and experience of the inventor and other persons actively working in the field; (2) the types of problems encountered in the field; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; and (5) the sophistication of the technology.

Leader contends that a person of ordinary skill in the art is someone with a bachelor's degree or higher in computer science and/or several years of experience in the computer industry.

Facebook contends that a person of ordinary skill in the art is someone with a bachelor's degree or higher in computer science and several years of experience in the computer industry.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3(c)(i) (February 2010) which cites *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 27-28 (1966); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666-67 (Fed. Cir. 2000).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.14**

This should not be a separate instruction or an issue decided by the jury. The Court's finding regarding the level of skill in the art should be incorporated into Proposed Jury Instruction No. 4.10, as Facebook has done. Facebook disagrees that a person skilled in the art could include one without a bachelor's degree or equivalent in computer science but who has several years of experience in "the computer industry," as this could include many individuals who are not, in fact, skilled in the art of computer programming.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.15
OBJECTIVE INDICATIONS CONCERNING NON-OBVIOUSNESS

In making these assessments, you should take into account any objective evidence (sometimes called "secondary considerations") that may have existed at the time of the invention and afterwards that may shed light on the obviousness or not of the claimed invention, such as:

- a. Whether the invention was commercially successful as a result of the merits of the claimed invention (rather than the result of design needs or market-pressure advertising or similar activities)?
- b. Whether there was a long felt need for a solution to the problem facing the inventors, which was satisfied by the claimed invention?
- c. Whether others had tried and failed to make the invention?
- d. Whether others invented the invention at roughly the same time?
- e. Whether others copied the invention?
- f. Whether there were changes or related technologies or market needs contemporaneous with the invention?
- g. Whether the invention achieved unexpected results?
- h. Whether others in the field praised the invention?
- i. Whether persons having ordinary skill in the art of the invention expressed surprise or disbelief regarding the invention?
- j. Whether others sought or obtained rights to the patent from the patent holder?
- k. Whether the inventor proceeded contrary to accepted wisdom in the field?

Answering any, or all, of the above questions “yes” may suggest that the claim was not obvious.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c (February 2010) which cites *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007); *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003); *Durel Corp. v. Osram Sylvania Inc.*, 256 F.3d 1298, 1306 (Fed. Cir. 2001).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.15**

Facebook objects to this instruction as it divides up several obviousness instructions into separate instructions. Facebook includes its proposed instructions regarding secondary considerations of non-obviousness in its Proposed Instruction No. 4.10. Facebook further objects to the addition of the sentence "Answering any, or all, of the above questions 'yes' may suggest that the claim was not obvious." This is an unnecessary addition to the model instruction.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.16

TEACHING AWAY

If the patentee proceeds contrary to accepted wisdom of prior art, this is strong evidence of non-obviousness.

AUTHORITY:

Uniform Jury Instructions for Patent Cases in the United States Court for the District of Delaware § 4.8.7 (March 1993); Final Jury Instruction No 4.7.9, Honeywell International Inc. v. Nikon Corporation, Case 1:04-cv-01337-JJF (D. Del. October 23, 2009).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.16**

Facebook objects to this instruction as improper. Leader cites to two authorities for this instruction, including a 1993 model Delaware instruction. The law of obviousness has changed substantially since 1993. *See KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Further, "Teaching away" is discussed in both Leader and Facebook's Proposed Jury Instruction Nos. 4.10. Also, the phrase "the wisdom" of the prior art is misleading and not an accurate statement, as a reference can teach away but "the wisdom" of the prior art cannot. This may allow the jury to believe that because Leader argues that any prior art reference allegedly taught away from the '761 patent, Facebook cannot prove its obviousness case.

After the parties' meet and confer, Leader chose to add a cite to "Final Jury Instruction No 4.7.9, *Honeywell International Inc. v. Nikon Corporation*, Case 1:04-cv-01337-JJF (D. Del. October 23, 2009)." This citation is inaccurate and misleading however, as this was not a final jury instruction, but rather an instruction that the plaintiff in a patent case *proposed*. This is not authority, but rather wishful thinking.

Leader has provided no authority that this questionable statement merits its own instruction, aside from another patentee desiring a similar instruction in a recent case, ignoring the defendants' objections thereto.

5.0 INEQUITABLE CONDUCT

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 5.1 INEQUITABLE CONDUCT

Every applicant for a patent has a duty of candor and good faith in its dealing with the United States Patent and Trademark Office. This is important because the PTO has limited resources.

When a person involved in the prosecution of an application fails to supply material information with an intent to deceive the PTO, he or she has committed what is called "inequitable conduct." When inequitable conduct occurs during the examination of an application, any patent that issues from that application is unenforceable as a matter of fairness. This means that despite the existence and validity of a patent, the patent holder may not prevent others from using the invention covered by the patent and may not collect damages from those who use the invention that is covered by the patent.

Facebook must prove by clear and convincing evidence that a person meaningfully involved in the prosecution of the '761 patent, such as the inventors or the prosecuting attorney, withheld material information from the PTO during the examination of the '761 patent, and that the person did so with an intent to deceive the Examiner into issuing the patent.

I will now explain to you what "material" and "intent to deceive" mean.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 5.1 (February 2010), which cites 35 U.S.C. § 282; *Larson Mfg. Co. of S.D. v. Aluminart Prods., Ltd.*, 559 F.3d 1317 (Fed. Cir. 2009) (vacating district court's determination of inequitable conduct because of lack of materiality); *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008) ("[A]t least a threshold level of each element—i.e., both materiality and intent to deceive—must be proven by clear and convincing evidence." (citations omitted)); *Digital Control Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1315 (Fed. Cir. 2006) (explaining PTO Rule 56 standards of materiality); *Ferring B.V. v. Barr Labs., Inc.*, 437 F.3d 1181 (Fed. Cir. 2006); *Dayco Prods., Inc. v.*

Total Containment, Inc., 329 F.3d 1358, 1363 (Fed. Cir. 2003); *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306 (Fed. Cir. 2000); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991); *Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867 (Fed. Cir. 1988).

LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY

INSTRUCTION NO. 5.1

Leader objects to this instruction for all the reasons set forth in its briefing in opposition to Facebook's motion to amend because the inequitable conduct claim that Facebook has in its proposed instruction is not a claim currently in this case. *See* D.I. 331. Leader reserves its right to provide a proposal should these allegations be permitted, as Facebook's proposed instruction misstates the law.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 5.2

INEQUITABLE CONDUCT - MATERIALITY

Information is material if it establishes, either alone or in combination with other information, that the invention sought to be patented was not patentable. Information is material if there was a substantial likelihood that a reasonable Examiner would consider it important in deciding whether to allow the application to issue as a patent. Withheld information that is cumulative of, or less relevant to any patentability requirement compared to information the examiner already had from any source, is not material (because the Examiner already had similar information on which to make a judgment of patentability).

Here, I instruct you that the iManage reference has already been deemed material by the PTO. Because the degree of materiality of the information is factored into the ultimate determination I make concerning the enforceability of the patent, the jury form will ask you to identify the issue for which the information or statements was material and to rate its materiality on a scale from low to high. You may only find information or statements to be material if there is clear and convincing evidence that they are material.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 5.1 (February 2010), which cites 35 U.S.C. § 282; *Larson Mfg. Co. of S.D. v. Aluminart Prods., Ltd.*, 559 F.3d 1317 (Fed. Cir. 2009) (vacating district court's determination of inequitable conduct because of lack of materiality); *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008) (“[A]t least a threshold level of each element—i.e., both materiality and intent to deceive—must be proven by clear and convincing evidence.” (citations omitted)); *Digital Control Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1315 (Fed. Cir. 2006) (explaining PTO Rule 56 standards of materiality); *Ferring B.V. v. Barr Labs., Inc.*, 437 F.3d 1181 (Fed. Cir. 2006); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1363 (Fed. Cir. 2003); *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306 (Fed. Cir. 2000); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991); *Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867 (Fed. Cir. 1988).

LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY

INSTRUCTION NO. 5.2

Leader objects to this instruction for all the reasons set forth in its briefing in opposition to Facebook's motion to amend because the inequitable conduct claim that Facebook has in its proposed instruction is not a claim currently in this case. *See* D.I. 331. Leader reserves its right to provide a proposal should these allegations be permitted, as Facebook's proposed instruction misstates the law. Additionally, Leader objects to this instruction because it makes improper statements regarding the iManage reference and the jury form.

In order for inequitable conduct to have occurred, Facebook must establish that any failure to disclose material information was done with an intent to deceive the Examiner.

Intent may be shown through indirect evidence or, in other words, it may be inferred from conduct. For example, if you find that a reference that was withheld was highly material, you may infer intent.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 5.1 (February 2010), which cites 35 U.S.C. § 282; *Larson Mfg. Co. of S.D. v. Aluminart Prods., Ltd.*, 559 F.3d 1317 (Fed. Cir. 2009) (vacating district court's determination of inequitable conduct because of lack of materiality); *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008) (“[A]t least a threshold level of each element—i.e., both materiality and intent to deceive—must be proven by clear and convincing evidence.” (citations omitted)); *Digital Control Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1315 (Fed. Cir. 2006) (explaining PTO Rule 56 standards of materiality); *Ferring B.V. v. Barr Labs., Inc.*, 437 F.3d 1181 (Fed. Cir. 2006); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1363 (Fed. Cir. 2003); *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306 (Fed. Cir. 2000); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991); *Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867 (Fed. Cir. 1988).

LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY

INSTRUCTION NO. 5.3

Leader objects to this instruction for all the reasons set forth in its briefing in opposition to Facebook's motion to amend because the inequitable conduct claim that Facebook has in its proposed instruction is not a claim currently in this case. *See* D.I. 331. Leader reserves its right to provide a proposal should these allegations be permitted, as Facebook's proposed instruction misstates the law.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 5.4

INEQUITABLE CONDUCT – BALANCING OF MATERIALITY AND INTENT

If you find that Facebook has proved by clear and convincing evidence that material information was withheld and, further, that these omissions were done with an intent to deceive the Examiner, you must then weigh the degree of materiality and the degree of intent to determine whether, on balance, the evidence clearly and convincingly establishes that the person who withheld information committed inequitable conduct and the patent should in fairness be declared unenforceable. When performing this balancing, the higher the level of materiality of the withheld information, the lower the level of intent that is required to establish inequitable conduct, and vice versa.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 5.1 (February 2010), which cites 35 U.S.C. § 282; *Larson Mfg. Co. of S.D. v. Aluminart Prods., Ltd.*, 559 F.3d 1317 (Fed. Cir. 2009) (vacating district court's determination of inequitable conduct because of lack of materiality); *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1365 (Fed. Cir. 2008) (“[A]t least a threshold level of each element—i.e., both materiality and intent to deceive—must be proven by clear and convincing evidence.” (citations omitted)); *Digital Control Inc. v. Charles Mach. Works*, 437 F.3d 1309, 1315 (Fed. Cir. 2006) (explaining PTO Rule 56 standards of materiality); *Ferring B.V. v. Barr Labs., Inc.*, 437 F.3d 1181 (Fed. Cir. 2006); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1363 (Fed. Cir. 2003); *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306 (Fed. Cir. 2000); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991); *Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867 (Fed. Cir. 1988).

LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY

INSTRUCTION NO. 5.4

Leader objects to this instruction for all the reasons set forth in its briefing in opposition to Facebook's motion to amend because the inequitable conduct claim that Facebook has in its proposed instruction is not a claim currently in this case. *See* D.I. 331. Leader reserves its right to provide a proposal should these allegations be permitted, as Facebook's proposed instruction misstates the law.

6.0 FALSE MARKING

LEADER'S PROPOSED JURY INSTRUCTION NO. 6.1 FALSE MARKING

In this case, Facebook has alleged that Leader falsely marked its Leader2Leader® product with the '761 Patent. To prove false marking, Facebook must establish that (1) Leader marked Leader2Leader® with the '761 Patent, (2) the '761 Patent does not cover the Leader2Leader® product, and (3) Leader marked the Leader2Leader® product with the intent to deceive the public.

Facebook must show by a preponderance of the evidence that Leader did not have a reasonable belief that the marked products were properly marked.¹

¹ Leader reserves its right to amend this instruction pending the decision of the *Pequinot v. Solo Cup Co.*, 646 F. Supp. 2d 790 (E.D. Va. 2009)(pending in Federal Circuit).

AUTHORITY:

Adapted from *Lazare Kaplan International, Inc. v. Photocopy Technologies, Inc.*, No. 2009-1251 (February 11, 2008) which cites 35 U.S.C. § 292; *Clontech Laboratories, Inc. v. Invitrogen Corporation*, 406 F.3d 1347 (Fed. Cir. 2005); *DP Wagner Manu., Inc. v. Pro Patch Systems, Inc.*, 434 F. Supp. 2d 445 (S.D. Tex. 2006); See also *Forest Group, Inc. v. Bon Tool Co.*, 590 F.3d 1295 (Fed. Cir. 2009)